

REMARKS

In the Office Action dated December 8, 2006, the Examiner objected to the specification and the claims. The Examiner also rejected the claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter as being intended to embrace two different statutory classes of invention and rejected the claims under 35 U.S.C. § 112, second paragraph, for the same reason. The Examiner finally rejected the claims under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. Applicant therefore respectfully provides the following:

Objections to the Specification:

In the Office Action, the Examiner objected to the specification for including several acronyms without including the language that the acronyms represent in the first instance the acronym is used. Applicant has amended the specification to provide this information. Applicant, however, did not amend the specification regarding the acronym “ACH,” as the terminology that the acronym represents was already provided in the acceptable form in the specification as filed at page 8, line 10. Applicant has complied with the Examiner’s requests regarding the acronyms “EDS,” “DDE,” “MICR,” and “DLL.” Applicant therefore requests withdrawal of the objections.

The Examiner also objected to Applicant’s inclusion of “What is claimed is:” on page 16 line 22, indicating that this recitation should be on the beginning of the first page of claims. Applicant has submitted amendments to comply with the Examiner’s request and respectfully requests withdrawal of the objection. Applicant respectfully submits that all objections to the specification have been dealt with by Applicant in this response.

Claim Objections:

In the Office Action, the Examiner objected to the claims because of informalities.

Applicant has amended the claims as requested by the Examiner. Applicant respectfully requests withdrawal of the objections. To the extent any such minor objectionable language may be found by the Examiner in the future and may remain as the only impediment to the prompt allowance of the application, Applicant respectfully requests that the Examiner propose an Examiner's amendment to correct such issues and contact the undersigned by telephone regarding such proposed amendment.

Claim Rejections under 35 U.S.C. §§ 101 and 112, Second Paragraph (Multiple Classes):

In the Office Action, the Examiner rejected all claims under 35 U.S.C. §§ 101 and 112, second paragraph as being “intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 U.S.C. § 101.” Specifically, the Examiner asserted that Applicant’s independent claims begin discussing a method, then deal with “the specifics of the system of the payment amount,” and subsequently deal with the specifics of a method. Applicant respectfully disagrees.

It is abundantly clear on reading Applicant’s claims that what is claimed is a method, and not a system. In no portion of Applicant’s claims is a system attempted to be claimed along with the claimed method. Each of the limitations of claim 10 begins with a proper gerund as is typical in method claims. The specific limitations of claim 10 begin with the following words: “generating and transmitting,” “receiving,” “preprocessing,” “effectuating,” “using,” “transmitting,” and “remitting.” Although Applicant’s claims, of necessity, recite some

structure, this is a common and accepted part of claiming practice and does not indicate that

Applicant's claims are directed to two different statutory classes of invention.

M.P.E.P. § 2173.05(p)(II) discusses when the type of rejection made by the Examiner in this case is proper. The only situation identified by this section is when a claim claims both an apparatus and a method steps of using the apparatus. This section of the M.P.E.P. cites two cases, and a comparison of these two cases to the present case is instructive as to why the Examiner's rejection is improper. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), the rejected claim was directed to "An automatic transmission tool in the form of a workstand and method for using same." Thus, the claim clearly indicated that it was directed to a tool as well as a method. This became even clearer in the body of the claim, which claimed various structures and then claimed specific method steps:

a support means,  
and [sic] internally splined sleeve affixed upright to said support means,  
a threaded adjustment bolt threadably engaged through a hole in the  
bottom of said support means and projecting upward through said support frame  
into said sleeve,  
and further comprising the steps of  
1. positioning the output end of an automatic transmission onto said  
upright sleeve,  
2. removing the internal components of said automatic transmission from  
the casing of said transmission,  
3. repairing and replacing said internal components back into said casing,  
and  
4. adjusting said internal components for fit and interference by means of  
adjusting said upwardly projecting adjustment bolt.

Clearly, the claim in *Ex parte Lyell* was directed to two classes of statutory subject matter and was improper.

In *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005), the claim held invalid was a dependent claim from a proper system claim. The problematic portion of the claim recited: "The system of claim 2 wherein . . . the user uses the

input means to either change the predicted transaction information or accept the displayed transaction type and transaction parameters.” (Emphasis added in the case.) Again, this is was a clear case of claiming a mix of subject matters in that the added limitation was for a method step instead of a structure in a system.

Such is not the case for Applicant’s claims. While Applicant’s claims recited some structure, Applicant’s claims are clearly directed to a method in all regards. To maintain otherwise is contrary to all established patent claiming practices. Virtually all method claims in issued patents recited some structure; otherwise, the claimed method steps would have no specificity or meaning. Take, as a simple hypothetical example, a method for nailing two boards together:

A method for nailing two boards together comprising:  
holding two boards together;  
placing a nail adjacent one of the boards; and  
striking the nail with a hammer until the nail penetrates the boards.

This simple hypothetical example recites a great deal of structure, namely: a nail, two boards, and a hammer. Yet, the claim clearly falls within a single statutory category of a method.

Remove the structure and the claim becomes:

A method for nailing two boards together comprising:  
holding together;  
placing adjacent; and  
striking with until penetrates.

This simple new claim has no meaning and is incomprehensible. Clearly, the structure is necessary and gives life to the meaning of the claim without placing the claim in two categories of statutory subject matter.

This is equally true of Applicant’s claims. For these reasons, Applicant respectfully submits that Applicant’s claims are not directed to two different statutory classes. Applicant respectfully refers the Examiner to the multitude of issued patents containing method claims that

include references to structure as part of the claims as evidence that Applicant's claims are clearly acceptable under U.S. patent law and USPTO claiming practice. Applicant therefore respectfully requests removal of the rejections of all claims under 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph, as being directed to non-statutory subject matter and being indefinite for the same reason.

Applicant respectfully notes that the Examiner has made no clear explanations as to how Applicant has allegedly claimed two classes of invention other than the mere inclusion of references to structure as part of the claiming of the method. Therefore, the Examiner has deprived Applicant of the opportunity of responding with more specificity to the Examiner's position. Applicant finds this unfortunate given the late stage of the prosecution at which the Examiner has suddenly made this rejection and given claims that have existed in essentially their current condition since at least March 2005.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph (Essential Step):

In the Office Action, the Examiner rejected all claims under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps. M.P.E.P. § 2172.01 sets forth that a rejection for omitting essential steps should only be made when the allegedly omitted matter is "disclosed to be essential to the invention as described in the specification or in other statements of record." The Examiner has not set forth that this is the case here, therefore, the Examiner's rejection should be removed.

In the Office Action, the Examiner did not make clear what step is allegedly missing from claims 10 and 18. The Examiner instead provided a listing of what claim 10 "should recite" without indicating what was already present and what was allegedly the missing step(s).

Given the Examiner's extensive use of ellipses (...), editing, and misquoting of the claim, Applicant is entirely unable to discern what matter the Examiner alleges is missing and where the Examiner feels this information should be inserted in the claim.

Additionally, the Examiner has made no assertion or explanation as to what supposedly-missing step Applicant has "disclosed to be essential to the invention" in the original disclosure or in any other statement of record. The most the Examiner ever states in the rejection is: "step is needed prior to" without indicating what step is allegedly missing, and without indicating where or when Applicant has disclosed this step as being "essential to the invention." Regarding claim 18, the Examiner has made no explanation whatsoever as to

Again, Applicant is extremely disappointed that the Examiner has made this rejection for the first time at this late stage in the prosecution with claims that have existed in their current form for a long period of time. Applicant is further disappointed that the Examiner has provided so little detail so as to deprive Applicant of any opportunity to address the Examiner's concerns in any meaningful way beyond the above brief discussion of why Applicant feels the rejection has not properly been made.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 10 day of March, 2007.

Respectfully submitted,

  
Michael W. Krieger  
Attorney for Applicant  
Registration No. 35,232

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4814  
Facsimile: (801) 321-4893

ADS  
954798.01